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**Datasheet for the decision
of 1 June 2023**

Case Number: T 2845/19 - 3.2.06

Application Number: 08712091.1

Publication Number: 2123241

IPC: A61F13/15, A61F13/49,
A61F13/494, A61F13/496,
A61F13/514

Language of the proceedings: EN

Title of invention:
PAPER DIAPER

Patent Proprietor:
Daio Paper Corporation

Opponents:
Patentanwälte Walther Hinz Bayer PartGmbB
Essity Hygiene and Health Aktiebolag

Headword:

Relevant legal provisions:
EPC Art. 14(2), 123(3)
RPBA 2020 Art. 11

Keyword:

Languages of the EPO - translation into official language of the EPO

Amendments - broadening of claim (yes)

Remittal - fundamental deficiency in first-instance proceedings (no)

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 2845/19 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 1 June 2023

Appellant: Essity Hygiene and Health Aktiebolag
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Representative: Essity Hygiene and Health AB
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Respondent: Daio Paper Corporation
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
20 August 2019 concerning maintenance of the
European Patent No. 2123241 in amended form.**

Composition of the Board:

Chairman M. Harrison
Members: M. Hannam
 W. Ungler

Summary of Facts and Submissions

- I. An appeal was filed by the appellant (opponent 2) against the interlocutory decision of the opposition division in which it found that European patent No. 2 123 241 in an amended form met the requirements of the EPC.
- II. The appellant requested that the decision under appeal be set aside and the patent be revoked in its entirety.
- III. In its reply to the appeal, the respondent (patent proprietor) requested that the appeal be dismissed.
- IV. The following document is relevant to the present decision:

D9 Certified translation into English of the originally filed application in Japanese
- V. The Board issued a summons to oral proceedings and a subsequent communication containing its provisional opinion, in which it indicated *inter alia* that the amendment, relative to claim 1 as granted, to "feature F27(e)" appeared to extend the protection conferred by the European patent, contrary to the requirement of Article 123(3) EPC.
- VI. With letter of 28 April 2023 the respondent requested that, should the appeal not be dismissed, the case be remitted to the opposition division for consideration of the auxiliary request filed on 7 December 2018 before the opposition division.

VII. Oral proceedings were held before the Board on 1 June 2023. At the close of the oral proceedings the requests of the parties were as follows:

The appellant requested that the decision under appeal be set aside and the patent be revoked.

The respondent requested that the appeal be dismissed (main request), auxiliarily that the case be remitted to the department of first instance for further prosecution.

VIII. Claim 1 of the main request reads as follows (with paragraph annotation as used by the opposition division in its decision):

"F1: An underpants type disposable diaper, comprising:
F2: a barrel-shaped waist portion (12) that includes
F3: a ventral-side outer sheet (12F) for covering a waist of a wearer on a ventral side and
F4: a back-side outer sheet (12B) for covering a waist of a wearer on a backside,
F5: in which the ventral- and back-side outer sheets are joined together at joined sections at edges on the both sides in a width direction; and
F6: an absorber (20) that is connected at a front end portion to the ventral-side outer sheet on an inner surface at a central portion in the width direction and is connected at a back end portion to the back-side outer sheet on an inner surface at a central portion in the width direction, and covers the back side through crotch portion to the ventral side,
F7: the ventral-side outer sheet (12F) and the back-side outer sheet being not connected but separated at the crotch portion, wherein
F8: the back-side outer sheet has a back-side main unit

section (13) that corresponds to the joined sections in an up-down direction, and a back-side extension section (14) that extends below the back-side main unit section,

F9: the back-side extension section has a central portion (14M) in the width direction overlapping the absorber and hip cover portions (14C) extending on both sides of the central portion,

F10: in the back-side outer sheet, the back-side main unit section has an upper end portion (W), a lower end portion (U), and an intermediate portion (M) between the two end portions in the up-down direction,

F11: a plurality of back-side waist elongated resilient and elastic members (15-18) is fixed to the upper end portion, at intervals in the up-down direction and in a state of being extended in the width direction at a predetermined extension ratio;

F12: a plurality of first elongated resilient and elastic members is fixed to the intermediate portion and the lower end portion at least in areas not overlapping the absorber, at intervals in the up-down direction and in a state of being extended in the width direction at a predetermined extension ratio;

F13: and a plurality of second elongated resilient and elastic members is fixed to at least the hip cover portions in the back-side extension section, at intervals in the up-down direction and in a state of being extended in the width direction at a predetermined extension ratio,

F14: the ventral-side outer sheet is composed of only a ventral-side main unit section that corresponds to the joined sections in the up-down direction

F15: in the ventral-side outer sheet, the ventral-side main unit section has an upper end portion, a lower end portion, and an intermediate portion between the two end portions in the up-down direction,

F16: a plurality of ventral-side waist elongated resilient and elastic members is fixed to the upper end portion, at intervals in the up-down direction and in a state of being extended in the width direction at a predetermined extension ratio;

F17: a plurality of third elongated resilient and elastic members (19T) is fixed to the intermediate portion at least in areas not overlapping the absorber, at intervals in the up-down direction and in a state of being extended in the width direction at a predetermined extension ratio; and

F18: a plurality of fourth elongated resilient and elastic members (19U) is fixed to the lower end portion at least in areas not overlapping the absorber, at intervals in the up-down direction and in a state of being extended in the width direction at a predetermined extension ratio,

F19: the back-side outer sheet and the ventral-side outer sheet are each formed by laminating two nonwoven fabrics

F20: with a basis weight of 10 to 30 g/m²,

F21: a length of the lower end portion of the back-side main unit section and a length of the lower end portion of the ventral-side main unit section are equal and 30 to 100 mm in the up-down direction,

F22: the hip cover portions are 80 to 160 mm long in the width direction, and the hip cover portions are 30 to 80 mm long in the up-down direction,

F23: the first elongated resilient and elastic members (15) in the lower end portion are 2 to 15 rubber threads made of synthetic rubber, 155 to 1880 dtex in fineness and 200 to 350% in extension ratio, and are arranged at intervals of 1 to 15 mm,

F24: the fourth elongated resilient and elastic members are 1 to 8 rubber threads made of synthetic rubber that are 155 to 1880 dtex in fineness and 150 to 350% in

extension ratio, and are arranged at intervals of 1 to 30 mm, and

F25: the second elongated resilient and elastic members (16) are 2 to 10 rubber threads made of synthetic rubber that are 155 to 1880 dtex in fineness and 150 to 300% in extension ratio, and are arranged at intervals of 5 to 40 mm

characterized in that

F26: the back-side waist elongated resilient and elastic members, the ventral-side waist elongated and elastic members, the first elongated resilient and elastic members, the second elongated resilient and elastic members, the third elongated resilient and elastic members, and the fourth elongated resilient and elastic members, are each specified in number, fineness, extension ratio, interval, kind of a material, and arrangement pattern in the up-down direction, such that an inclination angle of the joined sections is found to be 20 degrees or less according to a joined section inclination test which is carried out as follows:

F27:

- (a) an absorber is removed from a disposable diaper to use the waist portion alone as a specimen,
- (b) the specimen 12 is folded along a central line of the ventral-side outer sheet 12F in the product width direction and a central line of the back-side outer sheet 12B in the product width direction, such that the folded parts of the ventral- and back-side sheets each overlap inside and reference end lines L1 of the both joined sections 12A (center-side end edges in the width direction of the joined sections 12A) overlap,
- (c) the folded specimen 12 is inserted into one chuck C1 of a tensile tester in an area ranging from one folding line toward the joined section by 10 mm entirely in the product up-down direction, and inserted

into the other chuck C2 of the tensile tester in an area ranging from the other folding line toward the joined section by 10 mm entirely in the product up-down direction,

(d) the tensile test is conducted entirely in the product front-back direction,

(e) assuming that a distance between the chucks with the specimen 12 not stretched but naturally contracted (a naturally-contracted length) is designated as A and a distance between the chucks when the specimen is stretched until the specimen is no longer contracted by the resilient and elastic members (a maximum stretched length) as B, a protractor is used to measure an inclination angle θ of a virtual line L2 connecting the upper and lower ends of the joined section reference end line L1 in the product up-down direction when the specimen is stretched until the distance between the chucks reaches $(A+B)/2$, and the measured angle is the joined section inclination angle."

The wording of claim 1 of the auxiliary request is not relevant to the decision taken in respect of this request.

IX. The appellant's arguments relevant to the decision may be summarised as follows:

Main request

Claim 1 did not meet the requirement of Article 123(3) EPC.

According to granted claim 1, the distance B should be measured when the elastic members 'produce no contraction anymore'. Absent any indication in the patent of how this was to be measured, this reasonably corresponded to the point at which the members either

broke or lost their elastic properties. Even if that point were not reached, the inherent elasticity of the nonwoven fabrics of feature F19 in the specimen resulted in distance B as defined in claim 1 as granted being greater than the dimension of the specimen in its lie flat condition.

According to claim 1 of the main request, the specimen being stretched until it was no longer contracted by the elastic members corresponded to a state where the wrinkles in the specimen were flattened out.

The difference between these two measurements of B resulted in the distance between the chucks $(A+B)/2$ being shorter in the main request. Consequently, articles that fell outside the scope of protection of granted claim 1 now fell inside the scope of claim 1 of the main request.

If there were no difference between the two expressions, there would have been no need to file the amended wording. The bracketed wording 'a maximum stretched length' merely summarised or labelled the expressions which went before, but had no relevance to the difference between the respective foregoing expressions.

Auxiliary request

With the opposition division having found the main request before it to meet the requirements of the EPC, there was no procedural need to consider the pending auxiliary request. No procedural violation was thus committed by the opposition division and thus the case should not be remitted.

- X. The respondent's arguments may be summarised as follows:

Main request

Claim 1 met the requirement of Article 123(3) EPC. The definition of how distance B was measured in claim 1 of the main request and in claim 1 as granted were of identical scope. Both expressions defined the specimen being stretched until it was no longer contracted or, in other words, until the specimen was flat. This was consistent with the wording 'a maximum stretched length' included in brackets after each expression. Identical wording must have the same meaning. Any perceived lack of clarity could be resolved in the light of the description and drawings e.g. the inclination angle test in para. [0055] of the patent. It was not possible to stretch the resilient and elastic members more than the maximum stretched length of the specimen as the elastic members and specimen were fixed together and stretched and contracted as one. As for when the resilient and elastic members 'produce no contraction anymore', this could not be when the elastic members broke since the specimen would then be damaged such that the inclination angle measured at a chuck separation of $(A+B)/2$ would then not be representative as the specimen would have been destroyed. The maximum stretched length was logically to be measured at the smallest front-back direction of the specimen i.e. that at the waist rather than at the hip cover portions. The patent included no suggestion that the back-side outer sheet and ventral-side outer sheet had any elasticity of relevance.

Auxiliary request

The case should be remitted to the opposition division for further prosecution since the opposition division had failed to consider the auxiliary request on file

before it. The proprietor's right to be heard had thus been denied, which amounted to a substantial procedural violation.

Reasons for the Decision

1. *Main request*

Article 123(3) EPC

- 1.1 According to Article 14(2) EPC, a translation into one of the official languages of the EPO may, throughout proceedings before the EPO, be brought into conformity with the application as filed. During the opposition procedure, the proprietor filed amendments to the patent as granted in order to correct errors in the translation into English from the originally filed application in Japanese. These corrections were supported by D9.
- 1.2 According to Article 123(3) EPC, a European patent may not be amended in such a way as to extend the protection it confers. This requirement must therefore be met by claim 1 of the main request with respect to claim 1 as granted.
- 1.3 According to feature F27(e) in claim 1 of the main request, the distance B is defined as a distance between the chucks when the specimen is stretched until the specimen is no longer contracted by the resilient and elastic members (a maximum stretched length). This requirement corresponds to a condition in which the specimen must lie flat i.e. no longer be wrinkled. Both parties concurred with this interpretation.

1.4 In claim 1 as granted, the distance B was defined to be 'a distance between the chucks when the specimen is stretched until the resilient and elastic members produce no contraction anymore (a maximum stretched length)'.

However, when the specimen has been stretched to the extent that it lies flat i.e. is no longer wrinkled, the resilient and elastic members still generate a contraction force on the specimen i.e. the condition has not yet been reached in which the 'resilient and elastic members produce no contraction anymore'. There is no suggestion in the patent that the elastic members have been attached to the nonwoven sheets at their maximum elongation, and indeed such would be contrary to normal practice. It thus follows from claim 1 as granted that the resilient and elastic members are to be stretched beyond when the specimen lies flat in order for these members to 'produce no contraction anymore'. Consequently, distance B as measured according to claim 1 as granted will be greater than distance B measured according to claim 1 of the main request.

1.5 Thus, diapers that fell outside the scope of protection of granted claim 1 fall inside the protection of claim 1 of the main request, as the distance between the chucks $(A+B)/2$ is shorter in the main request. Consequently claim 1 of the main request confers a greater scope of protection compared to claim 1 as granted, contrary to the requirement of Article 123(3) EPC. The respondent did not deny this calculation in itself to be correct, if the distance B were indeed shorter in the main request compared to granted claim 1.

- 1.6 The respondent did however contend that the interpretation of the expressions for how distance B was measured in claim 1 of the main request and claim 1 as granted should be such that these were of identical scope.
- 1.7 This is not accepted by the Board. The condition in which the 'resilient and elastic members produce no contraction anymore' does not unambiguously refer solely to no more contraction being produced in the specimen, rather it indeed would be understood to be referring to the resilient and elastic members themselves no longer producing a contraction force which, as indicated in point 1.4 above, will necessarily be at a distance B greater than when the specimen lies flat. In this regard, the respondent's argument that the resilient and elastic members could not be stretched beyond their length at which the specimen was flattened, as these were fixed together and stretched and contracted as one is also not accepted. As defined in feature F19 of claim 1, the back and ventral side outer sheets are formed of nonwoven fabric which will always have a recognisable degree of elasticity. Thus, even with the resilient and elastic members being fixed to these outer sheets (which is done by affixing at separated locations), the elasticity of the outer sheets will allow the resilient and elastic members to extend beyond the lie flat condition of the specimen, these thus continuing to produce contraction at these extensions beyond the lying flat extension of the specimen. This has the consequence that distance B as measured according to claim 1 as granted is necessarily greater than distance B when measured according to claim 1 of the main request.

1.8 The respondent's contention that the wording 'a maximum stretched length', appearing in brackets after each expression, indicated that the two expressions had identical meaning is not convincing. In this respect, it is noted that expressions appearing in claims in parentheses are non-limiting and cannot be used to interpret the content or meaning of features in the claim. Furthermore, the bracketed wording in the context of claim 1 of the main request and claim 1 as granted is but a label seemingly summarising the content of the foregoing expressions. To this extent, it does not replace the foregoing expressions and so cannot be used to draw any conclusions regarding the meaning of these expressions.

1.9 Continuing its argument that the expressions in claim 1 of the main request and claim 1 as granted had the same meaning, the respondent argued that any lack of clarity in this regard could be resolved in the light of the description and drawings e.g. the inclination angle test in para. [0055] of the patent. The Board does not see, nor did the appellant argue, that there was any lack of clarity associated with the expressions in question; resorting to the description to interpret these is thus not necessary. Nonetheless, even if the description were consulted, no definition of the expression in question is included there, even para. [0055] referred to by the respondent, precisely mirrors the wording found in claim 1 and offers no further elucidation i.e. the specimen is stretched until the specimen is no longer contracted by the resilient and elastic members (a maximum stretched length). Notably, the corrections made in view of D9 to the claim and to the description were in total correspondence such that nothing in the description provided a different

interpretation of the claimed wording.

1.10 Further, according to the respondent, the instance at which the resilient and elastic members 'produce no contraction anymore' cannot be when the elastic members break since the specimen would then be damaged to such an extent that the inclination angle measured at a chuck separation of $(A+B)/2$ would no longer be representative. The Board sees no reason to disagree with this contention since the skilled person would see it to be technically unreasonable to extend the specimen until the elastic members ruptured. Nonetheless, as found in point 1.6 above, the back and ventral side outer sheets are formed of nonwoven fabric i.e. they will possess a recognisable degree of stretch, also to a certain degree elastically, even if they are not constructed to be elastic nonwoven sheets. Thus, even with the resilient and elastic members being fixed to these outer sheets, the stretchability of the outer sheets will allow the resilient and elastic members to extend beyond the lie flat condition of the specimen, these thus continuing to produce contraction at these extensions beyond the lying flat extension of the specimen. This has the consequence that distance B, when the resilient and elastic members produce no contraction anymore, as measured according to claim 1 as granted, will necessarily always be greater than distance B when measured according to claim 1 of the main request.

1.11 It thus follows that claim 1 of the main request has been amended relative to claim 1 as granted in such a way as to extend the protection conferred by the European patent, contrary to the requirement of Article 123(3) EPC. The main request is therefore not

allowable.

2. *Auxiliary request*

2.1 The respondent requested that the case be remitted to the department of first instance for further prosecution since the opposition division had failed to consider the auxiliary request on file before it, which allegedly amounted to a substantial procedural violation.

2.2 According to Article 11 RPBA 2020, a Board should not remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so. Fundamental deficiencies apparent in the proceedings before that department constituted such special reasons.

2.3 The opposition division found the main request before it to meet the requirements of the EPC. It was thus under no obligation to consider the auxiliary request on file as it had found a higher-ranking request to be allowable. That the opposition division did not consider the auxiliary request, did not deny the respondent of its right to be heard and did therefore not constitute a fundamental deficiency in those proceedings. Also, no other fundamental deficiency in those proceedings was alleged by the respondent. The respondent was also not prevented from falling back on that request when filing its response to the grounds of appeal, albeit it chose not to do so.

2.4 Absent a fundamental deficiency in the proceedings before the opposition division or any other special reason for doing so, the Board sees no reason to remit

the case to the opposition division.

2.5 The Board thus decided not to remit the case to the opposition division.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



D. Grundner

M. Harrison

Decision electronically authenticated